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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,019	03/31/2004	Peter Gerber	50037.0233US01	2899
27488 7590 06/05/2007 MERCHANT & GOULD (MICROSOFT) P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER CHAVIS, JOHN Q	
			ART UNIT 2193	PAPER NUMBER
			MAIL DATE 06/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,019

Applicant(s)

GERBER ET AL.

Examiner

John Chavis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The claimed invention is directed to non-statutory subject matter. The claimed invention in claims 15 and 22 is directed toward a test automation system from which an apparatus is expected; however, none of the components of the system appear to represent an apparatus. Claim 15 appears to be focused merely on an object and describing methods of the system; while, claim 22 describes various means; however, none of the means appear to be hardware components. That is, the claims appear to focus on either descriptive information or software components. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is either descriptive material (claim 15) or software (claim 22) which is not a tangible result because nothing in the claim specifies that a system existed initially; therefore, it is not clear how a new system can be generated without the initial system. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Sivakumar et al. (6,219,829).

We claim:

Sivakumar

1. A computer-readable medium having computer-executable components, comprising:

See Sivakumar's fig. 7, col. 10 lines 50-61 and col. 11 lines 1-11.

a test case scenario object that comprises test methods that are arranged to test an electronic system,

See col. 1 lines 22-30.

wherein the test methods that are arranged in a hierarchy that comprises a base class and subclasses,

See col. 1 lines 39-65, col. 3 lines 5-12 and 25-45.

wherein each of the subclasses derives from the base class, and

See col. 3 lines 38-45.

wherein the principle of inheritance is applied to each test method in accordance with the arrangement of the methods within the hierarchy; and

" " " "

a test harness that is arranged to provide system test services for the test methods.

the applicant describes the test harness as conventional (prior art), see the Applicant's background. He further indicates that it is used to execute test cases, which is considered the

2. The computer-readable medium of claim 1, wherein the principle of inheritance is selectively applied to subclass test methods.

3. The computer-readable medium of claim 1, wherein the subclass test method comprises an attribute that is arranged to determine whether to apply the principle of inheritance.

4. The computer-readable medium of claim 1, further comprising a test extraction engine that is configured to order the test methods according to the hierarchy.

5. The computer-readable medium of claim 4, wherein the test extraction engine is configured to use a comparison function that is defined within the attributes to order the test methods according to the hierarchy.

6. The computer-readable medium of claim 1, wherein the base class test methods comprise a setup method and a teardown method.

7. The computer-readable medium of claim 6, wherein the subclass test methods comprise a setup method and a teardown

functionality of Sivakumar's test management system in col. 5 lines 3-17.

See col. 3 lines 38-45 in which rules may or may not be inherited (selectively applied inheritance).

See col. 4 lines 9-15.

This feature is considered inherent via col. 3 lines 28-30 to ensure proper execution order.

See col. 3 lines 32-36.

See the setup and cleanup methods in col. 3 lines 49-64.

See col. 4 lines 18-29.

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method.

As per claims 8-14, 15-21 and 22-28, see the rejections of claims 1-7.

Claim 29 is rejected as claim 3 above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Chavis whose telephone number is (571) 272-3720. The examiner can normally be reached on M-F, 9:00am-5:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC



John Chavis
Primary Examiner AU-2193